

## **Remarks**

The various parts of the Office Action (and other matters, if any) are discussed below under appropriate headings.

### ***Prior Declaration Under 37 CFR §1.132***

The Examiner has found Mr. Hannington's declaration submitted on July 23, 2003 to be defective because the table mentioned in section 6 was not found. Applicant is resubmitting herewith a copy of an excerpt from Adhesion and Adhesives Technology by Alphonsus B. Pocius referred to in Mr. Hannington's declaration. On page 264 is the table mentioned in section 6 of the declaration.

### ***Claim Rejections - 35 USC § 112***

Claims 1-26 have been rejected under 35 U.S.C. §112, first paragraph, as being based on a disclosure that is not enabling. The Examiner contends that it is unlikely that the channels created by the embedded non-adhesive material forms would collapse under pressure to form a path of air egress. The Examiner further contends that the Declaration of Mr. Hannington fails to provide any evidentiary support regarding how air egress channels can be formed, and has requested a Declaration from a relatively disinterested person, such as a customer.

Applicant respectfully submits that the claimed invention is fully capable of being reduced to practice. The Declaration of Mr. Hannington, the inventor of the subject matter of this application, was submitted on July 23, 2003. In his declaration, Mr. Hannington explained how the pattern of non-adhesive material forms of the claimed adhesive article provide a path for air egress for air trapped between the adhesive layer and the surface to which the adhesive article is adhered.

By law, a patent application is presumptively enabled when filed. "When rejecting a claim under the enablement requirement of section 112, the PTO bears an initial burden of setting forth a reasonable explanation as to why it believes that the scope of protection by that claim is not adequately enabled by the description of the invention provided in the specification of the application; this includes, of course, providing sufficient reason for doubting any assertions in the specification as to the scope of the enablement." *In re Wright*, 999 F.2d 1557, 1561-62, 27 USPQ2d 1510, 1513 (Fed. Cir. 1993). The Examiner

has failed to support the rejection with evidence and/or technical reasoning explaining any failure to comply with §112, and further, has failed to consider the rebuttal explanation provided by Applicant. Therefore, Applicant respectfully requests withdrawal of the rejection of claims 1-26 based on 35 U.S.C. §112, first paragraph.

### ***Claim Rejections - 35 USC § 103***

Claims 27-29 and 32-52 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Rusincovitch et al. (US 5,676,787) in view of GB 1,511,060. The Examiner contends that it would have been obvious to one of ordinary skill in the art to modify Rusincovitch's pressure sensitive adhesive sheet to incorporate the recesses at the surface of the adhesive layer by printing and embedding the non-adhesive spacers into the adhesive layer and forming recessed ridges as taught by GB 1,511,060, motivated by the desire to be able to remove the air trapped between the bonded surfaces.

Applicant respectfully disagrees with the Examiner's contention. Rusincovitch teaches an adhesive layer coated on a layer of non-adhesive spacers releasably attached to a release sheet such that removal of the release sheet yields a surface in which spacers are flush with or protrude slightly from the surface of the adhesive. (See column 9, lines 43-45 and lines 51-55). It would not have been obvious to modify the wall covering of Rusincovitch to include non-adhesive spacers having a lower surface above the plane of the bottom surface of the adhesive layer. The method by which the wall covering of Rusincovitch is produced could not have produced Applicant's claimed adhesive article. Specifically, because an adhesive is first coated over the spacers and the adhesive layer with the spacers printed thereon is transferred to the wall covering substrate, the bottom surface of the spacers could not have been positioned above the plane of the lower surface of the adhesive layer as illustrated in Figures 4a and 4b of the present application.

GB '060 teaches an article with improved degassing properties comprised of an air impermeable plastic sheet and an underlying adhesive. The shape of the adhesive on the edge that adheres to a surface consists of elongated ridges and or recessions. Degassing of the article occurs when the adhesive layer is exposed to pressure and heat so that the adhesive layer collapses on the air spaces and conforms to a surface. GB '060 does not teach or suggest that patterned shapes could be made with non-adhesive material or that

non adhesive material forms would be desirable. In fact, the reference would discourage the use of non-adhesive material forms because GB '060 teaches that the patterns must collapse during the application so that the molten adhesive surface achieves a uniform thickness and smooth edge void of any preexisting pattern. Further, claim 27 recites that non-adhesive material forms are embedded into the lower surface of the adhesive layer wherein the bottom surface of the non-adhesive material forms are above the plane of the lower surface of the adhesive layer. Rusincovitch et al. fails to disclose, teach or suggest the adhesive article of claim 27, and the adhesive articles of claims 28-29 and 32-52 which depend from claim 27. GB '060 adds nothing to the teachings of Rusincovitch whereby material forms embedded as in claim 27 would be desirable. For these reasons, Applicant respectfully submits that the rejection of claims 27-29 and 32-52 has been overcome and respectfully requests withdrawal of the rejection.

### **Conclusion**

In view of the foregoing, request is made for timely issuance of a notice of allowance.

Respectfully submitted,

RENNER, OTTO, BOISSELLE & SKLAR, LLP

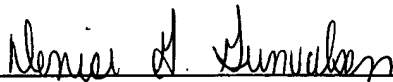
By   
Heidi A. Boehlefeld, Reg. No. 34,296

1621 Euclid Avenue  
Nineteenth Floor  
Cleveland, Ohio 44115  
(216) 621-1113

#### CERTIFICATE OF MAILING (37 CFR 1.8a)

I hereby certify that this paper (along with any paper or thing referred to as being attached or enclosed) is being deposited with the United States Postal Service on the date shown below with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Date: November 24, 2003

  
Denise G. Gunvalsen

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